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Section IV:
AMENDMENT UNDER 37 CFR §1.121
REMARKS

Summary of Telephone Interview

On August 11, 2004, Applicant's Agent, Robert H. Frantz, contacted Examiner Dada to request a copy of the reference relied upon for the novelty rejections, US Provisional Patent Application 60/210,922) to Crosbie, which was not included in the Office Action and is not available publicly.

Subsequently, Applicant's Agent received the requested copy. The Examiner's assistance is appreciated in this matter.

Rejections under 35 U.S.C. §102(e)

In the Office Action, the examiner has rejected claims Claims 1, 4 - 6, 9 - 11, 15 and 16 under 35 U.S.C. §102(e) for lack of novelty as being anticipated by U.S. Provisional Patent Application 60/210,922 to Crosbie (hereinafter "Provisional Crosbie").

Applicant hereby requests withdrawal of the rejections on the basis that a US Provisional Patent Application is not available as a reference under 35 U.S.C. §102(e) because it is not a "published patent application". 35 U.S.C. §102(e) states:

A person shall be entitled to a patent unless —

...

- (e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, ...

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As such, 35 U.S.C. §102(e) requires a reference applied under this section must either be a patent application published under 35 U.S.C. §122(b), or a granted patent. 35 U.S.C. §122(b) states:

(2) EXCEPTIONS.—

(A) An application shall not be published if that application is—

...

(iii) a provisional application filed under section 111(b) of this title; or...

Therefore, a US Provisional Patent Application is not published under §112(b), and thus cannot be applied as a reference under 35 U.S.C. §102(e). This is reflected in the Manual of Examination Procedure, as well. MPEP 2136.01 states:

2136.01 Status of U.S. Application as a Reference [R-2]

WHEN THERE IS NO COMMON ASSIGNEE OR INVENTOR, A U.S. APPLICATION MUST ISSUE AS A PATENT OR BE PUBLISHED AS A SIR OR AS AN APPLICATION PUBLICATION BEFORE IT IS AVAILABLE AS PRIOR ART UNDER 35 U.S.C. 102(e)

For this reason, application requests withdrawal of the rejection over Provisional Crosbie, as it is not a published patent application.

Additionally, Provisional Crosbie is not available as a non-patent publication as it contains no indication of a publication date (e.g. no copyright notice). Provisional Crosbie is clearly marked "Hewlett Packard Confidential", which would indicate it was not previously published.

For all of these reasons, application requests the withdrawal of the rejections of Claims 1, 4 - 6, 9 - 11, 15 and 16 over Provisional Crosbie.

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Art Made of Record by the Examiner

In the Office Action, Examiner made US Patent Applications 2002/0046275 and 2002/0083343, both to Crosbie (hereinafter Crosbie '275 and Crosbie '343), of record but did not rely upon them for the rejections. Both of these published patent applications claim priority to Provisional Crosbie, but it is unclear if Examiner considered one, or both, of them to anticipate our claimed invention.

Upon review of Provisional Crosbie as supplied by the Examiner, it is apparent that this provisional application may not meet the requirements of 35 U.S.C. §112 as to required content, and thus the subsequently filed non-provisional patent applications (Crosbie '275 and Crosbie '343) may not be due priority to Provisional Crosbie for its failure to meet the disclosure requirements of 35 U.S.C. §112. MPEP 2136.03 states:

III. PRIORITY FROM PROVISIONAL APPLICATION UNDER 35 U.S.C. 119(e)

The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.

Provisional Crosbie does not appear to be formatted properly as a US Patent Application, having none of the recommended sections (e.g. Background of the Invention, Summary of the Invention, etc.), and having no drawings with proper reference designators, etc. Provisional Crosbie appears to be a design specification (e.g. advance system requirements or objectives document) appended to a set of presentation slides, some of which is strongly oriented towards bullet-style presentations (e.g. incomplete sentences meant to prompt a speaker to elaborate verbally), and none of which are properly formatted or cross referenced between figures and text description.

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Rejections under 35 U.S.C. §103

In the Office Action, the Examiner has rejected Claims 2, 3, 7, 8 and 12 - 14 under 35 U.S.C. §103(a) as being unpatentable over Provisional Crosbie in view of non-patent document by Craig H. Rowland (hereinafter "Rowland") (noted as reference U by the examiner).

Applicant requests withdrawal of these rejections on the same grounds as set forth in the foregoing paragraphs, as Provisional Crosbie is not available as prior art under 35 U.S.C. §102(e), and thus is not available to combine with other art.

With respect to Rowland, the paper Applicant received for review contains an printed annotation at the bottom of the each page showing a date of 6/17/04, presumably a date the document was printed from the web site,

<http://ftp.cerias.purdue.edu/pub/tools/unix/logutils/logcheck/README.local>

which is also annotated at the bottom of each page in a fashion typical of a web browser printout. Visiting the supplied web address, it is apparent that these annotations are not part of the original document. June 17, 2004, does not predate our filing date of January 31, 2001.

Applicant's Agent notes at the top of page 1 of Rowland what appears to be a hand-written annotation "June 14, 2000". Examiner also included a printout for "Index of /pub/tools/unix/logutils/logcheck" from Apache Server, Version 1.3.29, which shows a "Last Modified" date for the file README.local.

It is not stated in the Office Action if this "Last Modified" date is considered to be the date of publication of this document. If so, applicant traverses affording this date to this document on the following grounds. Some operating systems maintain a file's date when the file is copied from one system to another. For example, if Mr. Rowland authored the file "README.local" on his personal or work PC (not on the Apache server computer) on June 14, 2000, then his computer would set the file date to 6/14/2000. But, this file may not have been available to the public, as most personal or work PC's hard drives are not accessible to the public. At a later date, when Mr. Rowland transfers the file README.local to the Apache Server computer at which time the file becomes publicly available, some operating systems will maintain the original

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file date as supplied by the origin computer, not setting it to the current system date of the receiving (e.g. Apache server) computer. In such a case, the file is not actually publicly available as of the date shown as "Last Modified". There appears to be no intention by Apache.org to provide a "published on" date as part of their Index generating function, which is fully described for Version 3 online at http://httpd.apache.org/docs/mod/mod_autoindex.html.

Applicant's Agent has performed a search using Google, which provides an automated caching and timestamping function for documents and pages on the Internet. A cached version of Rowland's document was found having the same URL cited by the examiner, but the caching date was August 14, 2004, not June 14, 2000.

MPEP 2128 states (emphasis added):

Date of Availability

Prior art disclosures on the Internet or on an online database are considered to be publicly available as of the date the item was publicly posted. If the publication does not include a **publication date (or retrieval date)**, it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b), although it may be relied upon to provide evidence regarding the state of the art. Examiners may ask the Scientific and Technical Information Center to find the earliest date of publication. See MPEP § 901.06(a), paragraph IV. G.

Additionally, MPEP 2128 states that the burden of establishing the date of availability for an electronically published document lies with the party asserting the document, which is the Examiner in this situation (emphasis added):

...See *In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981) ("Accordingly, whether information is printed, handwritten, or on microfilm or a magnetic disc or tape, etc., **the one who wishes to characterize the information**, in whatever form it may be, as a 'printed publication' * * * **should produce sufficient proof of its dissemination** or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.' " (citations omitted).)...

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It is not clear from the Office Action under what subpart of 35 U.S.C. §102 the Examiner considers Rowland to be available as prior art for combination or modification under 35 U.S.C. §103, and it is not clear whether or not Examiner considers the Apache Server Index "Last Modified" date to be a date of publication. Applicant requests clarification if the rejections are not withdrawn.

For these reasons, Applicant requests withdrawal of the rejections of Claims 2, 3, 7, 8 and 12 - 14. If Examiner maintains these rejections, or issues new rejections on new grounds which include the Rowland document, Applicant requests Examiner to make of record the method used to afford a specific date of publication, and under what part of 35 U.S.C. §102 Rowland is considered to be prior art.